

All communications respecting this case should identify it by number and names of parties.



**U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: BOX INTERFERENCE
Commissioner of Patents and Trademarks
Washington, D.C. 20231

OCT 06 1993

Telephone: (703)557-4007
Facsimile: (703)557-8642

PAT. & TRADEM. OFF.
U.S. DEPT. OF COMMERCE
WASHINGTON, D.C. 20231

In re application of: Tucholski :
Serial No.: 07/641,394 :
Filed: January 15, 1991 : PETITION FOR ACCESS
For: BATTERIES WITH TESTER LABEL :

In response to the letter of August 23, 1993 (Paper No. 19), applicant filed an Objection to Petition for Access (Paper No. 21), and petitioner filed a Response to Objection for Access (Paper No. 22).

Applicant asserts in his Objection that petitioner is only entitled to access to the instant application as filed (copy served on petitioner), because, in essence, the claims of Patent No. 5,223,003 all include the step of applying a contrasting color layer (step (c) of claim 1), which step was not and could not have been claimed in this application because it is not disclosed therein. Petitioner, on the other hand, asserts that the step in question was already known in the art, and that therefore "allowance [of the patent] necessarily was based upon considerations which can only be understood from the analysis of the prosecution of the parent application." Also, petitioner contends that he should be entitled to access to the prosecution in this application of the remainder of the subject matter recited in the claims of the '003 patent.

Serial No. 07/641,394


The claims of the '003 patent are drawn to a "process for preparing a label comprising a tester for a battery and for attaching it to a battery," while on the other hand all of the application claims are drawn to apparatus, i.e., to a battery or to a label, except for claim 45, which recites a process for attaching a label to a battery. The examiner required restriction between claims 1 to 44 and claim 45, finding that they were drawn to distinct inventions.

Accordingly, it is not considered that the apparatus claims in the application constitute subject matter claimed in the patent within the meaning of MPEP § 103. The petition is granted only to the extent that petitioner is granted access to the prosecution relating to process claim 45 of the application, viz., (1) the examiner's restriction requirement (Paper No. 4, 01/09/92); (2) applicant's response thereto (Paper No. 5); (3) the portions of the next Office action (Paper No. 6, 03/27/92) making the restriction requirement final, which are the first page, the first two paragraphs on page 2, and the last paragraph on page 3; and (4) parts of the amendment filed October 2, 1992 (Paper No. 7), consisting of page 4, the paragraph canceling claims 43-45, and page 5, the first paragraph under "Remarks."

The petition is granted to the extent indicated. However, the access granted herein will be withheld for a period

Serial No. 07/641,394

of twenty days from the date of this letter to provide applicant with an opportunity to take such action as he may deem appropriate if he disagrees with this decision. If no such action is taken, a copy of the papers as indicated in the preceding paragraph will be mailed to petitioner at the end of the twenty-day period.


Ian A. Calvert
Vice Chief Administrative
Patent Judge

Copies to:

Robert W. Welsh
Eveready Battery Company, Inc.
Checkerboard Square
St. Louis, MO 63164

(for Tucholski)

Stephen D. Murphy
Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

(Petitioner)

IAC/dls

10/7/93

Rec'd
10-7-93
OACP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Gary R. Tucholski
Serial No. : 07/641,394
Filed : January 15, 1991
For : BATTERIES WITH TESTER LABEL

United States Patents and Trademark Office
Office of the Assistant Commissioner for Patents
Attention: Gerald A. Dost, Special Program Examiner
Special Program Examination Unit
Crystal Park 2, Suite 919
Washington, D.C. 20231

SUPPLEMENTAL OBJECTION TO PETITION FOR ACCESS

Applicant has noted the comments of the Petitioner set forth in the Petition In Reply To Reply To Objection To Access mailed to the Office September 30, 1993. While Applicant is in marked disagreement with most of the arguments set forth in this Reply, closer examination of the claims in this application *vis-a-vis* those in the issued patent which forms the basis for the Petition For Access appears to render these arguments moot. This examination, more specifically, shows that at no time was there any prosecution whatever in this application of the invention set forth in the issued patent.

This application, as filed, contained claims 1-44 directed to "a battery" and claim 45 directed to a "process for attaching a label comprised of a tester for a battery to a battery." The Examiner, in the initial Office Action, required a restriction, grouping process claim 45 separately from claims 1-44 drawn to the battery. Claims 1-44 were elected for purposes of prosecution, and process claim 45 was subsequently canceled.

In re application of Tucholski
Serial No. 07/641,394
Page 2

Applicant added claims 46-53 to this application on October 2, 1992. Each of these claims, like original claims 1-44, is drawn to a "battery."

Applicant added additional claims to this application October 22, 1992. These additional claims, numbered 54-70, were copied from United States Patent 5,059,895 granted October 22, 1991, to Cataldi *et al.* These claims were presented for purposes of provoking an interference with the Cataldi *et al.* patent and appropriate Declarations Under 37 C.F.R. §1.608(b) accompanied them. Claims 54-61 were drawn to a "label." Claims 62-70, again, were drawn to a "battery."

Prosecution in this application, to date, has been limited to claims 1-44 drawn to a "battery," no Office Action addressing the merits of patentability having been issued since March 27, 1992. The claims in United States Patent 5,223,003 which forms the basis for the Petition, in contrast, are drawn to "a process for preparing a label." These inventions, obviously, are different whether one looks at the patent claim as a whole, as advocated in Applicant's original Objection, or whether one looks at the claim preamble, as is urged by Petitioner. Regardless of which test is used, no prosecution "was had in the earlier application of subject matter claimed in the patent." M.P.E.P. §103.

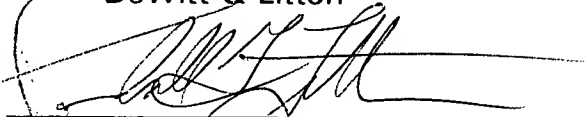
In re application of Tucholski
Serial No. 07/641,394
Page 3

The Petition For Access should be denied.

Respectfully submitted,

GARY R. TUCHOLSKI

By: Price, Heneveld, Cooper,
DeWitt & Litton

A handwritten signature in black ink, appearing to read 'R. Litton', is written over a horizontal line.

Randall G. Litton
Registration No. 24 013
695 Kenmoor, S.E.
Post Office Box 2567
Grand Rapids, Michigan 49501
(616) 949-9610

RGL:jkt
EVE01 A-310